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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,275	10/24/2001	William D. Tierney	G0008/7007	3532

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EXAMINER

TANG, KAREN C

ART UNIT PAPER NUMBER

2151

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/036,275

Applicant(s)

TIERNEY ET AL.

Examiner

Karen C. Tang

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/24/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Art Unit: 2151

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 40** is rejected under 35 U.S.C 101 because it is not limited to tangible embodiments: "carrier wave". The medium is not limited to tangible embodiments, instead being defined as including both tangible embodiment and intangible embodiment. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Peinado et al hereinafter Peinado (US 6,816,596).

Art Unit: 2151

1. Referring to Claims 1, 14, 27, 40, and 41, Peinado discloses (a) sending a request from the management server to the user to become a managed entity (refer to Col 7, Lines 14-25 and Col 11, Lines 40-60); (b) downloading from the management server to the client software a definition file containing a definition of the managed entity (refer to Col 3, Lines 55-67), and (c) associating information in the definition file with user identities and device in the client software in order to create a managed entity (refer to Col 3, Lines 24-67).

2 Referring to Claims 2, 15, 28, and 42, Peinado discloses wherein the managed entity is a managed user (a user, refer to Col 3, Lines 5-15) and the definition information file is an injectible identity file (refer to Col 2, Lines 55-67 and Col 3, Lines 1-25).

3. Referring to Claims 3, 16, 29, and 43, Peinado wherein the managed entity is a managed device (computing device 14, refer to Col 12, Lines 35-50) and the definition information file is a device information file (refer to Col 12, Lines 10-38).

4. Referring to Claims 4, 17, 30 and 44, Peinado does discloses wherein the device information file (refer to Col 12, Lines 10-38 and Col 14, Lines 15-35, it is inherent that Windows Operating System provides the Windows Reg Files)

Art Unit: 2151

5. Referring to Claims 5, 18, 31 and 45, Peinado discloses (d) sending at least one license file from the management server to the managed user (refer to Col 10, Lines 4-67); and (e) in response to information in the license file, enabling at least one function in the client software (refer to Col 13, and 14).

6. Referring to Claims 6, 19, 32 and 46: Peinado discloses (f) sending at least one policy restriction file (refer to Col 11 and 12) from the management server to the managed user; and (g) in response to information in the policy restriction file, restricting at least one function in the client software (refer to Col 13, and 14).

7. Referring to Claims 7, 20 and 33: Peinado discloses (h) creating a client list of licensed components and policy restrictions in the client software of the managed user (old version number, refer to Col 22, Lines 14-25 and certification, refer to Col 22, Lines 45-67); (i) sending the client list to the management server (Col 39, Lines 54-67, and Col 40, Lines 1-12), (j) creating a server list of licensed components and policy restrictions in the management server (refer to Col 11 and Col 12); (k) comparing the client list to the server list (refer to Col 20, Lines 12-67); and (l) adjusting and synchronizing the components in the client software based on the comparison on step (k) (refer to Col 22, Lines 15-30).

8. Referring to Claims 8, 21, and 34 Peinado discloses (l) comprises downloading and installing licensed components from the management server to

Art Unit: 2151

the client software which components are on the server list and are not on the client list (refer to Col 3, Lines 24-45).

9. Referring to Claims 9, 22 and 35, Peinado discloses wherein step (1) comprises revoking licenses in the client software of components are on the client list (black ox server/user server, refer to Col 12, Lines 3-65) and are not on the server list (content server, refer to Col 12, Lines 50-67).

10. Referring to Claim 10, 23 and 36, Peinado discloses wherein steps (h) to (1) are repeated periodically (refer to Col 3, Lines 24-45, Col 39, Lines 54-67 and Col 40, Lines 1-12).

11. Referring to Claims 11, 24, and 37 Peinado discloses (m) periodically sending event notifications and statistical information from the client software of the managed user to the management server (refer to Col 3, Lines 24-45, Col 39, Lines 54-67, and Col 40, Lines 1-12).

12. Referring to Claims 12, 25 and 38, Peinado discloses wherein the event notifications include error notifications (Examiner interprets the version number as an error notification, refer to Col 22, Lines 14-25 and Col 34, Lines 1-10)

13. Referring to Claims 13, 26 and 39, Peinado discloses wherein event notifications (old version number, refer to Col 22, Lines 14-25) and statistical

Art Unit: 2151.

information (certification, refer to Col 22, Lines 45-67) are temporarily stored in a memory located at a client site (refer to Col 21, Lines 60-67).

***Conclusion***

A shortened statutory period for reply to this Office action is set to expire **THREE MONTHS** from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ZARNI MAUNG**  
**SUPERVISORY PATENT EXAMINER**

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